

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of	:	Customer Number: 46320
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Yuhji YAMASHITA, et al.	:	Confirmation Number: 2216
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Application No.: 10/673,812	:	Group Art Unit: 2143
	:	
Filed: September 29, 2003	:	Examiner: M. Fearer
	:	
For: RELAY PROCESSING APPARATUS, CONTROL METHOD AND PROGRAM THEREFOR, AND TERMINAL CONTROL SERVER	:	

REPLY BRIEF

Mail Stop Appeal Brief - Patents
Commissioner For Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Reply Brief is submitted under 37 C.F.R. § 41.41 in response to the EXAMINER'S ANSWER dated March 5, 2009.

The Examiner's response to Appellants' arguments submitted in the Appeal Brief of December 8, 2008, raises additional issues and underscores the factual and legal shortcomings in the Examiner's rejection. In response, Appellants rely upon the arguments presented in the Appeal Brief of December 8, 2008, and the arguments set forth below.

REMARKS

Appellants have compared the statement of the rejection found on pages 3-14 of the Examiner's Answer with the statement of the rejection found on pages 2-13 of the Third Office Action. Upon making this comparison, Appellants have been unable to discover any substantial differences between the respective statements of the rejection. As such, Appellants proceed on the basis that the Examiner's sole response to Appellants' Appeal Brief is found on pages 14-20 of the Examiner's Answer in the section entitled "Response to Argument."

Referring to the paragraph spanning pages 14 and 15 of the Examiner's Answer, the Examiner makes the following assertion: "[t]he control request processor of the Application is read as an EJB container in the reference." Appellants' analysis in the Appeal Brief is based upon a reading of the bottom of page 17 of the Third Office Action that the servlets are being alleged by the Examiner as corresponding to the claimed control request processor. As such, the Examiner's failure to clearly indicate the features being relied in rejecting the claims has caused Appellants to reevaluate the Examiner's analysis. In this regard, the Honorable Board is asked to consider the Examiner's analysis on pages 4 and 5 of the Examiner's Answer (the same analysis presented on page 4 of the Third Office Action) and identify how it would be possible for anybody reading the Examiner's analysis to come to the conclusion that the Examiner is relying upon an "EJB container" to teach the claimed "control request processor."

Within the same paragraph of the Examiner's Answer, the Examiner made the following additional assertion: "[t]he control program of the Application is read as a web container in the

reference." In response, reference is made to the paragraph spanning pages 14 and 15 of the Third Office Action in which the Examiner "explicitly" identified the claimed features allegedly corresponding to the claimed "control program." This passage, however, is entirely silent as to any mention of a "web container." As such, the Examiner has again presented an inconsistent analysis.

Within the same paragraph¹ of the Examiner's Answer, the Examiner made the following assertion:

and for transmitting to said terminal request processor a notification that said first command has been received (page 67) (emphasis added)

Referring to page 18 of the Third Office Action, which included the Examiner's clarification as to what allegedly disclosed the claimed "a notification that a first command has been received," although the Examiner refers to page 16 of Vilaghy, the Examiner did not refer to page 67 on page 18 of the Third Office Action. As such, the Examiner has again presented analysis that is not consistent with the Examiner's prior analysis.

Referring to the paragraph spanning pages 16 and 17 of the Examiner's Answer, the Examiner made the following additional assertion: "[t]he terminal request processor of the Application is read as a WebServer Plugin in the reference."

On page 17 of the Examiner's Answer, the Examiner made the following assertions:

responsive to the reception notification, for returning the first command to said HTTP server program, and means in the HTTP server program for returning said command to the terminal in said HTTP response issued for said HTTP request (pages 124 and 154).

Referring to page 19 of the Third Office Action, which included the Examiner's clarification as

¹ The Examiner also cites to page 67 regarding the same limitation on page 17 of the Examiner's Answer.

to what allegedly disclosed the claimed "returning the first command to the HTTP server program" and "returning the command to the terminal in the HTTP response," although the Examiner refers to page 134 and Figure 10-4 of Vilaghy, the Examiner does not refer to pages 124 and 154. As such, the Examiner has yet again presented analysis that is not consistent with the Examiner's prior analysis.

Based upon the Examiner's numerous clarifications, the chart presented on page 10 of the Appeal Brief is revised as follows:

Claimed Feature	Teaching within Vilaghy
control program	web container; Fig. 10-3 and pg. 133
terminal	Web terminal translation program, DFHWBTTA, pg. 156 and Fig. 13-5
HTTP server program	HTTP server; Fig. 8-1 and pg. 113
terminal request processor	WebServer Plugin; Fig. 10-3 and pg. 133
control request processor	EJB container; Fig. 10-3 and pg. 133
notification that a first command has been received	pg. 67
returning the first command to the HTTP server program	pg. 124 and 154
returning the command to the terminal in the HTTP response	Same as immediately above.

Considering that the Examiner has completely modified how the Examiner is viewing the applied prior art, Appellants will focus on just a few of the claimed limitations to establish the Examiner's error:

As claimed, the control request processor includes means for transmitting to the terminal request processor a notification that said first command has been received. Based upon the Examiner's new analysis, (i) the control request processor is disclosed by the EJB container, (ii) the terminal request processor is disclosed by the WebServer Plugin, and the "notification that a first command has been received" is disclosed within page 67 of Vilaghy.

A review of page 67 of Vilaghy fails to yield any mention of the EJB container communicating anything to a WebServer Plugin. In fact, the WebServer Plugin is not mentioned in page 67 and the only communications described with regard to EJBs are that "EJBs can connect to back-end systems using connectors." As such, Appellants are entirely unclear as to how this passage teaches the claimed "notification that a first command has been received."

As claimed, the terminal request processor includes means, responsive to the reception notification, for returning the first command to said HTTP server program. Based upon the Examiner's new analysis, (i) the reception notification is disclosed within page 67, (ii) the terminal request processor is disclosed by the WebServer Plugin, (iii) the HTTP server program is disclosed by the HTTP Server, and (iv) the "returning the first command to the HTTP server program" is disclosed somewhere within pages 124 and 154 of Vilaghy. As such, the Examiner has not properly characterized the scope and content of the applied prior art.

As already noted above, exactly what within Vilaghy discloses the notification that a first command has been received (i.e., the reception notification) has not been established. The only discussion of a Server Plugin is found on the very top of page 124, which states:

1 The HTTP server compares the user specified value myservlets in the URL with a matching
2 Service directive in the httpd.conf file, recognizes that this is a servlet or JSP request, and passes it
3 forward to the WebSphere Application Server Plugin.
4

5 Although this passage refers to passing information to the Server Plugin, this passage is silent as
6 to what the WebServer Plugin sends.
7

8 Referring to page 154, Vilaghy teaches that the WebServer Plugin passes a EXCI request
9 to a CICS region. However, entirely absent from page 154 is a teaching that the WebServer
10 Plugin returns a first command to the HTTP server. As such, the Examiner has not properly
11 characterized the scope and content of the applied prior art.
12

13 As claimed, the HTTP server program includes means for returning the command to the
14 terminal in the HTTP response issued for the HTTP request. As discussed in the chart, the
15 Examiner also cited pages 124 and 154 of Vilaghy as teaching these limitations. Page 154 does
16 not describe the HTTP response issued for the HTTP request. As such, this page does not appear
17 to be relevant to the claimed limitations at issue. Although Figure 9-2 on page 124 illustrates a
18 response that issued in response to a request, page 124 is completely silent as to the contents of
19 this response. As such, the Examiner has not properly characterized the scope and content of the
20 applied prior art.
21

22
23 On page 11, line 22 through page 13, line 7 of the Appeal Brief, Appellants presented
24 several arguments regarding the sufficiency of the Examiner's obviousness analysis. For
25 example, Appellants argued that the Examiner has failed to properly ascertain the differences
26 between the prior art and the claims at issue, which is one of the Graham factual inquiries. The

Examiner's response to these arguments is found in three separate instances on pages 17-20 of the Examiner's Answer. However, as will be discussed in greater detail below, these three separate responses are almost identical.

Referring to the paragraph spanning pages 17 and 18 of the Examiner's Answer, the Examiner asserted the following:

Vilaghy et al. discloses a relay processing apparatus for relaying communications between a web container (read as a control program) that generates control commands for a terminal and a process for an HTTP server program that returns to said terminal a command constituting an HTTP response to a HTTP request received from said terminal, comprising: a terminal request processor for initiating said control program upon the reception of a function call from said HTTP server program that initially received said HTTP request from the terminal (page 23); and an FJB container (read as a control request processor) for receiving from said control program a first command generated as a response to the function call, and for transmitting to said terminal request processor a notification that said first command has been received (page 67), and means in the web server plugin (read as a terminal request processor) responsive to the reception notification, for returning the first command to said HTTP server program, and means in the HTTP server program for returning said command to the terminal in said HTTP response issued for said HTTP request (pages 124 and 154). (emphasis added)

The above reproduced "response" to Appellants' response is merely a reproduction of the analysis that the Examiner has presented in each of the first three Office Actions and in the Examiner's Answer with a couple of modifications.

This first modification is that where the Examiner previously reproduced language from Vilaghy, the Examiner is now just citing the page number (e.g., "page 67," "page 23," "pages 124 and 154"). The Examiner's other set of modifications involving replacing a previously identification of a claim term (e.g., "control program") with the phrase comparing the claim term to the teaching in Vilaghy (e.g., "a web container (read as a control program)"). The Examiner did this for the claimed (i) control program, (ii) control request processor; and (iii) terminal request processor. Other than these slight modifications, the Examiner's analysis is essentially identical to what is found in each of the first three Office Actions and in the Examiner's Answer

As a result of the Examiner presenting essentially identical analysis to what the Examiner has already presented before, the Examiner has failed to address Appellants' arguments. Specifically, the Examiner has failed to ascertain the differences between Vilaghy and the claimed invention.

Referring to the paragraph spanning pages 18 and 19 of the Examiner's Answer, this paragraph is identical to the paragraph spanning pages 17 and 18 of the Examiner's Answer and addressed above. Referring to the paragraph spanning pages 19 and 20 of the Examiner's Answer, this paragraph is also identical with the exception of the final assertion on page 20 that:

Though found in different embodiments of the Vilaghy et al. reference, they are all from the same invention and would have been obvious to combine for the purpose of passing web pages from a backend server to a terminal via a secure gateway.

Apparently, the Examiner believes that a combination of all of the different embodiments described by Vilaghy would have been obvious since "they are all from the same invention."

Although the Examiner has failed to allege that Vilaghy teaches all of the claimed limitations, for sake of argument, Appellants will proceed on the basis that the Examiner made such an argument. If so, the rejection would have been a rejection under 35 U.S.C. § 102 for anticipation. However, a prior art reference which contains a broad disclosure requiring guessing, testing, speculation or "picking and choosing" from a broad disclosure does not constitute an identical description of a claimed invention within the meaning of 35 U.S.C. § 102. Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc., 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992); Air Products & Chemicals, Inc. v. Charles S. Tanner Co., 219 USPQ 223 (D.S.C. 1983).; In re Arkley, 455 F.2d 586, 172 USPQ 524 (CCPA 1972).

What the Examiner's analysis essentially proposes, however, is picking and choosing certain elements from different teachings within Vilaghy and combining them in the manner claimed, which is exactly what is prohibited in the case law discussed above.

Turning to the Examiner's alleged motivation for this combination, the Examiner asserted that it "would have been obvious to combine for the purpose of passing web pages from a backend server to a terminal via a secure gateway." Appellants respectfully submit that the Examiner's proposed combination has no more relevance to "passing web pages from a backend server to a terminal via a secure gateway" than an improved intermittent windshield wiper motor has to the handling performance of an automobile. To achieve the alleged purpose identified by the Examiner requires a secure gateway connected to a server and backend server and does not require any claimed elements identified by the Examiner.

Referring to page 7 of the Appeal Brief, it is uncontroverted by the Examiner that the Examiner's is relying upon Rationale (G) within the Examination Guidelines for Determining Obviousness. As such, since the Examiner is employing TSM jurisprudence, the Examiner is required to establish a reasonable expectation of success as to a particular benefit. However, the Examiner's proposed combination does not provide this benefit. Instead, the Examiner's proposed benefit results from elements that are separate from the proposed combination. As such, the Examiner has failed set forth the requisite findings to establish a prima facie case of obviousness.

For the reasons set forth in the Appeal Brief of December 8, 2008, and for those set forth herein, Appellants respectfully solicit the Honorable Board to reverse the Examiner's rejections under 35 U.S.C. § 103.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

Date: May 5, 2009

Respectfully submitted,

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